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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,639	12/19/2001	Anthony Patrick Mauro II	020151	5037
23696 7590 07/22/2009 QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121				
EXAMINER				
LANIER, BENJAMINE				
ART UNIT		PAPER NUMBER		
2432				
NOTIFICATION DATE		DELIVERY MODE		
07/22/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/029,639

Applicant(s)

MAURO ET AL.

Examiner

BENJAMIN E. LANIER

Art Unit

2432

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 15, 16, 19-23, 25, 26, 28, 29 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 15, 16, 19-23, 25, 26, 28, 29 and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 13 April 2009 amends claims 12, 15, 16, 19-23, 25, 28, and 31. Claims 1-11, 13-14, 17-18, 24, 27, 30, and 34-43 have been cancelled. Applicant's amendment has been fully considered and entered.

Response to Arguments

2. Applicant's arguments, with respect to the 112, first paragraph rejections of claims 22-25 have been fully considered and are persuasive. The 112, first paragraph rejections of claims 22-25 have been withdrawn.

3. Applicant's arguments, with respect to Dierks, Huber, and Pathmasuntharan have been fully considered and are persuasive. The §103 rejections of claims 12, 14-16, and 18-33 have been withdrawn.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12, 15, 20-23, 25, 26, 28, 29, 31, 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70; Diehr, 450 at U.S. at 192; see also Flook, 437 U.S. at 589 n.9. The mere field-of-use limitations are generally insufficient to render an otherwise ineligible process claim patent-eligible. See Diehr, 450 at U.S.

at 191-92. In this case, the claims are considered non-statutory because the claimed process is not tied to a particular machine or apparatus. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008).

6. Since *Bilski* was decided, the Board of Patent Appeals and Interferences ("BPAI") has rendered several decisions analyzing whether methods claiming the assistance of computers and communications networks are sufficiently tied to particular machines to satisfy the "machine" prong of the *Bilski* test. Several of those decisions hold that claims reciting the use of general purpose processors or computers do not satisfy the test. *See, e.g., Ex parte Gutta*, No. 2008-3000 at 5-6 (BPAI Jan. 15, 2009) (rejecting under Section 101 a claim reciting a "computerized method" of inputting and representing XML documents as insufficiently tied to "a particular computer specifically programmed for executing the steps of the claimed method"); *Ex Parte Cornea-Hasegan*, No. 2008-4742 at 9-10 (BPAI Jan. 13, 2009) (rejecting under Section 101 a claimed method for predicting results of mathematical operations, finding that "[t]he recitation of a 'processor' performing various functions is nothing more than a general purpose computer that has been programmed in an unspecified manner to implement the functional steps recited in the claims").

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 16, 19, and 33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim elements “means for initiating” and “means for transmitting” are a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. The specification includes an I/O (Figure 1, 106), a processor (Figure 1, 102), and a memory (Figure 1, 104). However, the specification does not link either of the claimed means, mentioned above, with any of the elements from figure 1.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN E. LANIER whose telephone number is (571)272-3805. The examiner can normally be reached on M-Th 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Benjamin E Lanier/
Primary Examiner, Art Unit 2432